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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/682,348	10/09/2003	Stephen M. Zaudtke	200304323-4	8753

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EXAMINER

SHIN, CHRISTOPHER B

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/682,348

Applicant(s)

ZAUDTKE ET AL.

Examiner

Christopher B. Shin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 072520056.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

### DETAILED ACTION

1. On September 14, 27, and 29, the examiner and Mr. Dan C. Hu had extensive discussions in an attempt to expedite the prosecution. The examiner thanks Mr. Hu for the helpful cooperation. During the discussions, the examiner found the claimed term "emulation", "emulating", "emulate" not clear from the context of the claim. The examiner kindly asks the applicant to clarify the claimed "emulate" in response to this office action.

### ***Double Patenting Rejection***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 9-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,654,816. Although the conflicting claims are not identical, they are not patentably distinct from each other because, as can be seen from the combinations of claims 1, 2 & 6 of the (816) patent, the emulation function seems to be performed or provided by

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the (816) patent. Therefore, the present claims are obvious over the parent patent (816) patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

4. Examiner would like to note that any amendments to claims 1-8 would mostly likely require Double Patenting rejection.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 9 & 17 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Tognazzini (US2002/0029295).

a. Tognazzini reference teaches all of the claimed limitations as follows:

<u>Claims 1, 9, 17</u>	<u>Tognazzini (figures 1-13)</u>
------------------------	----------------------------------

- |                                       |                    |
|---------------------------------------|--------------------|
| • A CPU                               | ○ Feature of (155) |
| • A peripheral bus coupled to the CPU | ○ Feature of (150) |

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- A management processor coupled to the peripheral bus
  - Feature of processes/functions that are involved in communicating with a second computer of figure 2
- An infrared transceiver coupled to the management processor
  - Feature of [0009]
- The management processor enabling an external device to emulate any one or more of a keyboard, a mouse, a disk drive, and a monitor via the infrared transceiver
  - Feature of [0009], [0017],[0046],[0048]
- An interface to communicate with a handheld device
  - Feature of [0009]
- A processor to interact with the handheld device through the interface to enable the handheld device to emulate a pointer device function and a display function of the system
  - Feature of the operation of (240) in relation with a system of figure 1
- Communicating with a handheld device through an interface
  - Feature of [0009], [0017], [0046], [0048]
- Interacting with the handheld device through the interface to enable the handheld device to emulate a pointer device function and a display function of the system
  - Feature of the operation of (240) in relation with a system of figure 1

b. Since the Tognazzini reference teaches all of the claimed limitations, the claimed invention would have been clearly anticipated by the teachings of the Tognazzini reference.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2-8, 10-16 & 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tognazzini (2002/0029295).

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c. The teachings of the parent claims 1, 9 & 17 have been discussed above and applied here.

d. After careful consideration of the dependent claims, the examiner finds that the limitations of the dependent claims are related to common practices in the portable computing art with wireless communication. Examiner also cited some of the well known/commonly practiced knowledge art in the 892 so the applicant should carefully consider the prior art of record. Furthermore, the examiner give official notice on the limitations of the dependent claims as being commonly practiced knowledge in the art of portable computing art with wireless communication. For the above reasons, the it would have been obvious at the time the invention was made to one having ordinary skill in the art to further add limitations are commonly practiced in the art to the teachings of the gist of the present invention of the Tognazzini reference.

4. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woodruff (6,438,711).

e. In figures 1-7, Woodruff reference teaches the claimed limitations as follows:

<u>Claims 1, 9, 17</u>	<u>Woodruff (figures 1-13)</u>
------------------------	--------------------------------

- A CPU
  - Feature of (201)
- A peripheral bus coupled to the CPU
  - Feature of (220-230)
- A management processor coupled to the peripheral bus
  - Feature of (111-112), see the entire description of fig. 2
- An infrared transceiver coupled to the management processor

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- Obvious feature of (112)
- The management processor enabling an external device to emulate any one or more of a keyboard, a mouse, a disk drive, and a monitor via the infrared transceiver
  - Feature of (111)
- An interface to communicate with a handheld device
  - Feature of (120) communicating with (110)
- A processor to interact with the handheld device through the interface to enable the handheld device to emulate a pointer device function and a display function of the system
  - Feature of Col 8, lines 27-36
- Communicating with a handheld device through an interface
  - Feature of (120) communicating with (110)
- Interacting with the handheld device through the interface to enable the handheld device to emulate a pointer device function and a display function of the system
  - Feature of Col 8, lines 27-36

f. As for the claims 1, 9 & 17, the difference between the claimed invention and the teachings of the Woodruff reference is that the Woodruff reference does not expressly teach the infrared communication between external devices and the management processor. The Woodruff reference openly teaches or suggests different types of "transmission media"; in addition, at the time of the invention, infrared communication was commonly known and utilized in the data communication art. The examiner takes official notice on such well-known utilization; see also the examiner cited prior art. Therefore, it would have been obvious at the time the invention was made to one having ordinary skill in the art substitute one of well known types (e.g., infrared) as a transmission media in the Woodruff to come up with the invention for the reasons stated above.

g. As for the dependent claims 2-8, 10-16 & 18-23, after careful consideration of the dependent claims, the examiner finds that the limitations of the dependent claims are related to common practices in the portable computing

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art with wireless communication. Examiner also cited some of the well known/commonly practiced knowledge art in the 892 so the applicant should carefully consider the prior art of record. Furthermore, the examiner give official notice on the limitations of the dependent claims as being commonly practiced knowledge in the art of portable computing art with wireless communication. For the above reasons, the it would have been obvious at the time the invention was made to one having ordinary skill in the art to further add limitations are commonly practiced in the art to the teachings of the gist of the present invention of the Woodruff reference.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher B. Shin whose telephone number is 571-272-4159. The examiner can normally be reached on 6:30-5:00 M,Tu,Th,F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on 571-272-4083. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CHRISTOPHER SHIN  
PRIMARY EXAMINER  
OF 2182

September 29, 2005  
cbs

A handwritten signature in black ink, appearing to read 'C. Shin', is written over the printed name and title.